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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/716,012

11/18/2003

Truc Chi Vu

LA0084 (NP)

4194

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7590

08/25/2006

EXAMINER

YOUNG, SHAWQUIA

LOUIS J. WILLE

BRISTOL-MYERS SQUIBB COMPANY

PATENT DEPARTMENT

P O BOX 4000

PRINCETON, NJ 08543-4000

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/716,012

Applicant(s)

VU ET AL.

Examiner

Shawquia Young

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 9-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/10/04, 7/14/05, 8/4/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

Claims 1-34 are currently pending in the instant application.

### **I. *Priority***

The instant application claims benefit of US Provisional Application 60/431,814, filed on December 9, 2002.

### **II. *Information Disclosure Statement***

The information disclosure statement (IDS) submitted on May 10, 2004 is not in partial compliance with the provisions of 37 CFR 1.97 because of a missing English translation or concise explanation of the relevance of several references in the Other Documents Section. Accordingly, the information disclosure statement has been considered partially by the examiner.

The information disclosure statements (IDS) submitted on July 14, 2005 and August 4, 2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

### **III. *Restriction/Election***

#### ***A. Election: Applicant's Response***

Applicants' election without traverse of Group I in the reply filed on July 31, 2006 is acknowledged.

Subject matter not encompassed by elected Group I are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

### III. Rejections

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

In the genus compound in claim 1, the group  $-C-NR^7R^8COR^4$  in the definition for the variable  $R^2$  has too many bonds attached to the nitrogen atom. Applicants are suggested to remove one of the substituents attached to the nitrogen or add a positive charge to the nitrogen.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the terms "comprising" and "comprises" found in multiple instances in claims 1-8 renders the products indefinite as the term comprising is considered open-ended language and therefore is including additional subject matter in the compounds of the formula I that is not described in the instant specification and is not particularly pointed out or distinctly claimed. A claim to a chemical compound cannot be open-ended, but must be claimed with precision. For example, an alkyl group comprising 1 to 6 carbon atoms can be read to include additional atoms or groups other than carbon and alkyl, however, the identity of the additional atoms or groups and how to determine the identity of the additional atoms or groups is not pointed out or distinctly claimed. This rejection can be overcome by

amending all instances of the terms "comprising" and "comprises" in claims 1-8 to the phrases "consisting of" or "consists of".

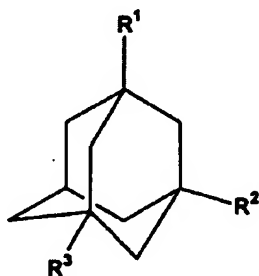
***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by *Hermann, et al.*, (US3325478, 1964). The instant invention claims a genus compound

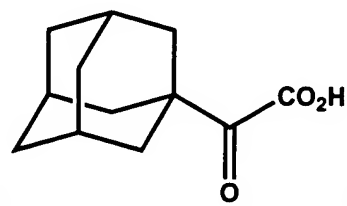


with the structure

wherein R<sup>1</sup> is H or OH; R<sup>2</sup> is  $-\text{C}(=\text{O})-\text{COR}^4$ , -

$\text{C}(=\text{O})\text{NR}^5\text{R}^6$ ,  $-\text{C}(\text{X})_n-\text{COR}^4$  and  $-\text{C}-\text{NR}^7\text{R}^8\text{COR}^4$ ; X is a halogen; n is from 1-2; R<sup>4</sup> is O-alkyl, NH<sub>2</sub>, and OH; R<sup>5</sup>-R<sup>8</sup> are H or COOR<sup>9</sup>; R<sup>9</sup> is a substituted or unsubstituted alkyl; and R<sup>3</sup> is H or OH.

The *Hermann, et al.* reference teaches the synthesis of  $\alpha$ -amino-1-adamantylmethyl



penicillins and uses the following species with the structure

as

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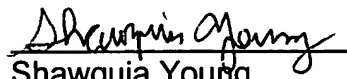
an intermediate. This species compound anticipates the genus compound of claim 1 of the instant invention (See page 2, column 3, line 75).

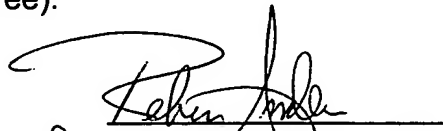
#### IV. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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